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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,684	03/30/2000	Larry D. Kinsman	3056.IUS (96-803.1)	8722
7590 Joseph A Walkowski Trask Britt & Rossa P O Box 2550 Salt Lake City, UT 84110			EXAMINER GRAYBILL, DAVID E	
			ART UNIT 2894	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY D. KINSMAN
And
JERRY M. BROOKS

Application 09/538,684
Technology Center 2800

Mailed: February 19, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on September 22, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, ARGUMENTS

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed September 17, 2007 under the heading “Argument” have not been clearly provided. Each grounds of rejection must be treated under a **separate heading** in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellant has not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. Specifically, the Appeal Brief states that “claims 1-4, 6, 8-12, 14-20, 22, 24-29, 31, 33-37 and 39-45 are unpatentable under 35 U.S.C. § 103(a) over Hernandez (U.S. Patent 4,994,936) [page 20, Grounds of Rejection to be Reviewed]. However, page 52 of the “Argument” section states that “[c]laims 1-4, 6, 8, 11, 12, 14-16, 18-20, 24-29, 31, 33, 36, 37 and 39-45 stand rejected under 35 U.S.C. § 103(a) over Hernandez (U.S. Patent 4,994,936). *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

EXAMINER’S ANSWER, MISSING CERTIFIED TRANSLATION

The Examiner relied on the foreign reference to Nakamura (JP 5102338) in rejecting the claims. A full certified English translation of the above

noted foreign reference is not of record in the Image File Wrapper (IFW).¹

When an Examiner relies on a document “in a language other than English, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added). *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) § 1207.02. Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: (1) a rejection is supported in whole or part by an abstract without reference to the underlying document, . . . ; or (2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English.

The memorandum also states “[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added).

INFORMATION DISCLOSURE STATEMENT

Appellants filed an Information Disclosure Statement (IDS) dated April 7, 2008. There is no indication on the record that the Examiner has

¹ It is noted that a Japanese Abstract and a computer-generated translation were included with the Non-Final Rejection mailed March 21, 2007. However, the first page of the translation states that the translation “is produced by machine translation and may contain errors.”

considered the above IDS. MPEP § 609 requires the Examiner to consider any IDS filed by Appellants if timely submitted. A written communication notifying Appellants of the Examiner's consideration of the above IDS is required.

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on September 13, 2007 defective;
- 2) to notify Appellants to file a paper properly presenting the arguments for each ground of rejection;
- 3) for consideration of said paper;
- 4) to obtain a full certified English language translation for Nakamura (JP 5102338);
- 5) to complete the IFW by having the translation obtained scanned into the IFW file;
- 6) to provide a copy of the translation obtained to Appellants;
- 7) for acknowledgement and consideration of the IDS filed April 7, 2008; and
- 8) for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

Application 09/538,684

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